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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/605,246      | 06/28/2000  | David L. Patton      | 81219F-P            | 5703             |

1333 7590 01/14/2005

PATENT LEGAL STAFF  
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EXAMINER

CARTER, MONICA SMITH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3722

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/605,246

**Applicant(s)**

PATTON ET AL.

**Examiner**

Monica S. Carter

**Art Unit**

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over de Passillé ('573) in view of Beasley ('195).

de Passillé discloses a kit for producing an official postal product having personal image comprising a first sheet having a plurality of official postal products (11), each of the products having a first official area (area containing "CANADA" (15) and "43" (16) as seen in figure 4) having an official postal indicia and a second area (14) for receiving a personal image; a second sheet having a plurality of labels (12) each having a personal image (as seen in col. 3, lines 19-22, de Passillé disclose the definitive stamp part 11 being provided on a roll 21 that is separate from the image-bearing parts 12, thus providing first and second sheets), each of the labels being designed for placement in the second area of the official postal product (as seen in col. 1, lines 56-61 and col. 2, lines 59-61).

de Passillé discloses the claimed invention except for the labels having a protective coating such that an official postal cancellation mark will not be permanently adhered to the personal image.

Beasley discloses a method of making personalized postage stamps comprising the steps of scanning (102) an image (104) into a storage; storing the image in a data

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base (110); selecting a substrate (112) for which the image is to be added; sizing the retrieved image (114); applying the image(s) to the substrate (116); evaluating the combined substrate and image product (118) and optionally applying a protective coating (120) onto the printed side of the final product (see page 3, col. 1, lines 11-25). Beasley also discloses providing different techniques for the cancellation of stamps (as seen on page 3, col. 2, lines 35-51). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify de Passillé's invention to include a protective coating placed over the personal image, as taught by Beasley, to protect the life of the stamp (see page 3, col. 2, lines 24-26). Inherently, this protective coating would prevent a cancellation mark from adhering to the personal image.

Regarding the first official area being capable of retaining an official postal cancellation mark, de Passillé, as modified by Beasley, discloses providing a protective coating over the personal image as set forth above. Depending on the placement of the protective coating (e.g., not on the first official area), the first official area would be *capable of* retaining an official postal cancellation mark. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. Therefore, the reference applied is required to only be "capable" of performing the claimed function.

***Response to Arguments***

3. Applicant's arguments filed October 4, 2004 have been fully considered but they are not persuasive.

Applicant argues that de Passillé, as modified by Beasley, fail to disclose coating only the personal image area of the claimed combined structure since Beasley is directed to coating the entire structure. The applicant contends that this combination teaches away from providing a section for receiving a cancellation mark as claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., coating only the personal image) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As claimed, a plurality of labels each having a personal image has a protective coating thereon. The limitation does not require that the coating be placed only on the personal image. As set forth in the rejections above, de Passillé, as modified by Beasley disclose providing a protective coating 120 over a personal image of a postage stamp. Therefore, the examiner maintains that de Passillé, as modified by Beasley discloses the presently claimed invention.

For the reasons as set forth above, the rejections are maintained.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (571) 272-4475. The examiner can normally be reached on Monday-Thursday (6:00 AM - 3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 12, 2005

*Monica S. Carter*

**MONICA S. CARTER  
PRIMARY EXAMINER**